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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/605,680	10/17/2003	Chih-Yuan Chen	MTKP0089USA	2679
27765	7590	01/10/2008		
NORTH AMERICA INTELLECTUAL PROPERTY CORPORATION P.O. BOX 506 MERRIFIELD, VA 22116			EXAMINER LAMB, CHRISTOPHER RAY	
			ART UNIT 2627	PAPER NUMBER
			NOTIFICATION DATE 01/10/2008	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/605,680	Applicant(s) CHEN, CHIH-YUAN	
	Examiner Christopher R. Lamb	Art Unit 2627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-6 and 8-21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claim 1:

The subject matter that was not described in the specification is "an Endec controller, coupled to the write strategy generator, for generating an APC mode signal and a predefined NRZI pattern having a run length changing according to a relationship between recording speed and a bandwidth of the photodiode."

Specifically, that the run length is "changing" is not supported.

The Endec controller is described on page 9 (paragraph 31) of the originally filed specification. There it states that the Endec controller "generates a specific NRZI pattern...designed according to the relative relationship between the recording speed and the FMD bandwidth."

This is followed by an example: "For a relatively slow FMD response, a larger run length can be selected as shown in Fig. 8, where the 11T mark length is selected for the purpose of power control."

This paragraph states that the Endec controller generates a specific NRZI pattern: meaning the specific NRZI pattern it was designed to generate. It does not state that the controller **changes** the NRZI pattern. Again, the paragraph states "the specific NRZI pattern is **designed** according to the relative relationship..."

An Endec controller that generates a NRZI pattern selected during the apparatus' design is very different than the claimed subject matter, which is an Endec controller that generates a **changing** NRZI pattern.

The example in this paragraph is a description of how the run length is selected during the process of designing the Endec controller. This is shown by the "for a relatively slow FMD response..." The FMD response does not change in a given apparatus. Therefore this example must refer to the design of the Endec controller: it indicates that when the apparatus is designed with a slow FMD response, an appropriate pattern is chosen during the design for the Endec controller to output.

Additionally, the Endec controller is depicted as box 105 in Fig. 7. The Endec controller is not shown having any inputs. This indicates that it is designed to output a specific, pre-chosen pattern rather than judging the speed and bandwidth in order to **change** the pattern.

Since the paragraph describing the controller does not disclose that it changes the NRZI pattern, only that the pattern has been selected appropriately during the

design of the apparatus, the subject matter in question was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claims 2-6, 8, and 9:

They are dependent on claim 1.

Regarding claim 10:

It contains language similar to that of claim 1.

Regarding claims 11-17:

They are dependent on claim 10.

Regarding claims 18-21:

Claim 18 contains language similar to that of claim 1; claims 19-21 are dependent on claim 18.

Response to Arguments

3. Applicant's arguments with respect to claims 1-6 and 8-21 have been considered but are moot in view of the new ground(s) of rejection.

Applicant argued that Watabe in view of Kenjo does not disclose an Endec controller that changes the run length. The Examiner agrees that Watabe in view of Kenjo does not disclose this, and therefore the rejection based on Watabe in view of Kenjo has been withdrawn.

However, upon reviewing Applicant's originally filed specification, the Examiner has concluded that Applicant did not disclose an Endec controller that changes the run

length either. Therefore the claims have been rejected under 35 USC 112, first paragraph, as noted above.

Conclusion

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher R. Lamb whose telephone number is (571) 272-5264. The examiner can normally be reached on 9:00 AM to 6:30 PM Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Korzuch can be reached on (571) 272-7589. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

CRL 1/3/08

/William Korzuch/
SPE, Art Unit 2627